

REMARKS

Specification has been amended to incorporate the original disclosure provided in original claim 4 with regard to the collet being expandable. In view of the fact that this structure was present in the original disclosure in claim 4, no new matter has been added. In addition, character reference 54 has been added to identify the spud nut when it originally present in the specification.

If the Examiner requires the drawings to be amended with dashed lines to show the expandability of the collet, such corrected drawings will be provided.

Claims 1-3 have been cancelled inasmuch as they do not include the expandable collet.

Claims 4-6 have been rejected by the Examiner under 35 USC 112, first paragraph, as failing to comply with the enablement requirement.

The Applicants submits that 35 USC 112, first paragraph, simply requires that the claims set forth and circumscribed a particular area with sufficient degree of precision and particularity, which is the case here. *In re Moore*, 169 USPQ 236 (CCPA 1971).

As set forth in *In re Gardener*, an original claim is adequate "written description" (first paragraph of 35 USC 112) of claimed invention and is equally a "written description" when located among the original claims or in descriptive part of the specification. *In re Gardener*, 177 USPQ 149 (CCPA 1973) and *In re Gardener*, 177 USPQ 396 (CCPA 1973).

In the case at hand, the Applicants submit that the description of the collet as being expandable is a sufficient enabling disclosure. An original claim in itself constitutes a description in the original disclosure. Nothing more is necessary for

compliance with the description requirement. Enzo Biochem v. Gen-Probe, Inc., 63 USPQ 2d 1618 (CAFC-2002).

In view of these holdings, the Applicants submits that the original disclosure meets the enablement requirement under 35 USC 112, first paragraph, and respectfully request the Examiner to withdraw the rejection of claims 4-6 on this basis.

Claims 1-2 (now cancelled) and 4-5 have been rejected under 35 USC 102(b) as being anticipated by U.S. 5,500,226 to Basile, et al. In this rejection, the Examiner refers to element 28 in Figure 5 and a description at column 4, lines 26-33 and considers the spud nut and the adapter to be unitary. The Examiner has included claims 4-5 stating that there is no characteristic of the collet of the instant invention which defines over Basile, et al. The Applicant, of course, disagrees with the Examiner and traverses the rejection as follows.

The Applicant submits that anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of the claimed invention. RCA Corp. v. Applied Digital Data Systems, Inc. 221 USPQ 385 (Fed. Cir. 1984); *In re Sun*, 31 USPQ 2d 1451 (CAFC 1993); Advanced Display Systems, Inc. v. Kent State University, 540 USPQ 2d 1673 (CAFC 2000).

Further, the Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. *Ex Parte Levy*, 17 USPQ 2d 1461 (USPTO Board of Patent Appeals and Interferences 1990).

In addition, the Applicant submits that anticipation must meet strict standards, and unless all of the same elements are found in exactly the same situation and united in the same way to form identical function in a single prior art reference, there is no anticipation. Tights, Inc. v. Acme-McCary Corporation, et al., 191 USPQ 305 (CAFC 1976).

Bearing in mind this criteria, it is clear that the Basile, et al. reference does not include an expandable collet and accordingly a rejection of claims 4-5 under 35 USC 102(b) is not sustainable. Therefore, the Applicant respectfully requests the Examiner to withdraw the rejection of claims 4-5 under 35 USC 102(b) on the basis of the Basile, et al. reference.

Claims 3 (cancelled) and 6 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Basile stating the well known existence of a sponge, which official notice has been taken by the Examiner.

While the existence of sponge may be well known, its application and combination with the present invention is not.

First, with regard to the Examiner's broad statement of the well known existence of sponge is factually unsupported with regard to its application in the present combination. It has been held that factually unsupported opinions of the Examiner do not provide the factual basis required by the Supreme Court in the Deere case (148 USPQ 459 (1966)) for the determination of obviousness under section 103 (*In re* Wagner and Folkers, 152 USPQ 512 (CCPA 1967)).

Wagner and Folkers states that neither can such (Examiner) opinions established a "presumption" of obviousness, and that subjective opinions are of little weight against contrary evidence.

In the present rejection, the Examiner's conclusion that the invention would have been obvious does not discharge the Examiner from the burden of providing the requisite factual basis and establish a requisite motivational support for a conclusion of obviousness. *Ex parte* Stern, 13 USPQ 2d 1379 (BPAI 1989). Thus, the Applicant submits that the Examiner has, in fact, not made a prima facie of obviousness of the invention as defined in claim 6 on the basis of the Basile, et al. and the existence of

sponge. Therefore, the Applicant respectfully requests the Examiner to withdraw the rejection of claim 6 under 35 USC 103(a).

In view of the arguments hereinabove set forth and amendment to the claims and specification, it is submitted that each of the claims now in the application define patentable subject matter not anticipated by the art of record and not obvious to one skilled in this field who is aware of the references of record. Reconsideration and allowance are respectfully requested.

Respectfully submitted,



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